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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Application Number: 10/628,029

Confirmation Number: 3361

Filing Date: July 25, 2003

Applicant(s): Nonaka Takaaki

Entitled: WORKFLOW PROCESS CONSOLIDATION

Examiner: Mark A. Fleischer

Group Art Unit: 3624

Attorney Docket No.: JP920020094US1 (600)

TRANSMITTAL OF APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith is Appellant's Appeal Brief in support of the Notice of Appeal dated September 9, 2010. Please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: December 9, 2010

Respectfully submitted,

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Customer Number 46320

PATENT

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APPEAL BRIEF

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Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed September 9, 2010, wherein the Appellant appeals from the Examiner's rejection of claims 1, 3-8, and 10-15.

I. REAL PARTY IN INTEREST

The subject patent application (the "Application") has been assigned to International Business Machines Corporation by assignment recorded on July 25, 2003, at Reel 014343, Frame 0675.

II. RELATED APPEALS AND INTERFERENCES

Appellant is unaware of any related appeals and interferences.

III. STATUS OF CLAIMS

Claims 1, 3-8, and 10-15 are pending in the Application and have been rejected at least twice. It is from the multiple rejections of claims 1, 3-8, and 10-15 that this Appeal is taken. Claims 2 and 9 have been cancelled previously.

IV. STATUS OF AMENDMENTS

No claims were amended after the final official action dated June 9, 2010 (the "Final Office Action").

V. SUMMARY OF CLAIMED SUBJECT MATTER

Embodiments of Appellant's invention provide a workflow system, a workflow server, a workflow engine, and a workflow process consolidation

method for managing a workflow. As set forth in paragraph [0008] of the original specification, one embodiment of Appellants' invention provides a workflow engine that, when nodes to be processed by one participant are in consecutive order and a form reaches the first node, consolidates information necessary for the participant's determination on the consecutive nodes, and sends the consolidated information to the participant. The participant receiving the information makes a decision based on the information, and sends results of work to the workflow engine. The workflow engine performs necessary processing for each node based on the information sent from the participant to advance the workflow. The sequence of the operations allows the participant to complete work at a time instead of repeating the same work multiple times as required in the conventional art.

With specific respect to claim 1, a workflow system has been claimed. (Par. [0008], line 14) The workflow system includes operating computer terminals executing a workflow and a workflow server connected with the operating computer terminals in a network to manage the workflow. (Par. [0008], lines 15-18) The workflow server consolidates information necessary for processing in multiple consecutive nodes to be processed by at least one participant operating one of the operating computer terminals. (Par. [0008], lines 18-20) When a form to be circulated in the workflow reaches a first one of the multiple consecutive

nodes to be processed by the at least one participant, the workflow server consolidates information necessary for the at least one participant's determination, generates a new form based on the consolidated information, and sends the new form with the consolidated information to the operating computer terminal for use by the at least one participant in making the participant's determination. (Par. [0009], lines 1-5; Par. [0022], lines 11-15)

With specific respect to claim 5, a workflow server connected with multiple computer terminals to manage a workflow has been claimed. (Par. [0010], lines 1-3) The workflow server includes means for storing a definition of nodes assigned to respective participants performing a workflow; means for determining a range of consolidating multiple consecutive nodes to be processed by at least one participant in the workflow; means for acquiring from the means for storing, a plurality of work items, wherein each of the plurality of work items is selectable for each node within the consolidation range determined by the means for determining a range of consolidation; and means for consolidating the work items acquired by the means for acquiring to provide the at least one participant with consolidated information. (Par. [0010], lines 3-14) When a form to be circulated in the workflow reaches a first one of the multiple consecutive nodes to be processed by the at least one participant, the workflow server consolidates information

necessary for the at least one participant's determination, and generates a new form based on the consolidated information. (Par. [0022], lines 7-15)

With specific respect to claim 8, a workflow engine connected with multiple computer terminals to manage a workflow has been claimed. (Par. [0012], lines 1-3) The workflow engine includes consolidation range determining means for determining a range of consolidating multiple consecutive nodes to be processed by at least one participant in the workflow; access permission setting means for setting access permission to each field at each node within the consolidation range determined by the consolidation range determining means; selectable work acquiring means for acquiring a plurality of work items, wherein each of the plurality of work items is selectable for each node within the consolidation range determined by the consolidation range determining means; and consolidating means for consolidating the work items acquired by the means for acquiring to provide the at least one participant with consolidated information. (Par. [0012], lines 3-12) When the form to be circulated in the workflow reaches a first one of the multiple consecutive nodes to be processed by the at least one participant, the consolidating means consolidates information necessary for the at least one participant's determination. (Par. [0022], lines 7-15) The workflow engine further includes form generating means for generating a new form based on the access

permission set by the access permission setting means and consolidating means; and form sending means for sending the at least one participant the form generated by the form generating means. (Par. [0012], lines 12-17)

With specific respect to claim 12, a workflow process consolidation method for consolidating a plurality of work items for each of multiple nodes assigned in a workflow to at least one participant operating a computer terminal connected to a network has been claimed. (Par. [0014], lines 1-5) The method includes determining the range of consolidating multiple consecutive nodes to be processed by the participant based on a workflow definition stored in a storage device; acquiring work items selectable for each node within the determined consolidation range from the workflow definition stored in the storage device; and consolidating the acquired selectable work items. (Par. [0014], lines 5-15) When a form to be circulated in the workflow reaches a first one of the multiple consecutive nodes to be provides by the at least one participant, the workflow server consolidates information necessary for the at least one participant's determination. (Par. [0022], lines 7-15) The method further includes generating a new form based on the consolidated information, and providing the participant with the new form with the consolidated information through the network. (Par. [0014], lines 15-20)

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The rejection of claims 1, 3-8, and 10-15 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,816,902 to Bandat et al. (Bandat) in view of Eugene Deborin et al., CONTINUOUS BUSINESS PROCESS MANAGEMENT WITH HOLOSOFX BPM SUITE AND IBM MQSERIES WORKFLOW, IBM Redbooks (May 2002), hereinafter "Deborin", and further in view of Rajiv Dewan et al., WORKFLOW REDESIGN THROUGH CONSOLIDATION IN INFORMATION-INTENSIVE BUSINESS PROCESSES, hereinafter "Dewan".

VII. THE ARGUMENT

THE REJECTION OF CLAIMS 1, 3-8, and 10-15 UNDER 35 U.S.C. § 103

On pages 3-15 of the Final Office Action, Examiner has rejected claims 1, 3-8, and 10-15 as being unpatentable over Bandat in view of Deborin and further in view of Dewan. For the convenience of the Honorable Board, claims 3-4 stand or fall together with independent claim 1, claims 6-7 stand or fall together with independent claim 5, claims 10-11 stand or fall together with independent claim 8, and claims 13-15 stand or fall together with independent claim 12.

With respect to the Examiner's determination of obviousness in the Final Office Action, Section 2141 of the Manual of Patent Examining Procedure

(M.P.E.P.) sets forth guidelines intended to assist personnel of the United States Patent and Trademark Office in making a proper determination of obviousness under 35 U.S.C. 103, and to provide an appropriate supporting rationale in view of recent judicial developments in regard to 35 U.S.C. § 103. Included as part of M.P.E.P. 2141 are the "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.," 73 Fed. Reg. 57,526 (2007) (hereinafter the Examination Guidelines). Section III of M.P.E.P. 2141 is entitled "Rationales To Support Rejections Under 35 U.S.C. 103."

Referring to Section III of the Examination Guidelines, the following is a list of rationales that may be used to support a finding of obviousness under 35 U.S.C.

§ 103:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) "Obvious to try" - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;

(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Upon reviewing Examiner's analysis on pages 3-9 of the Final Office Action, Examiner appears to be employing rationale (A). If Examiner has employed a different rationale under the Examination Guidelines, Appellant requests Examiner to clearly state the rationale being applied in an Examiner's Answer.

With respect to rationale (A), the Examination Guidelines set forth a precise process for which the Examiner must follow in order to establish a prima facie case of obviousness under 35 U.S.C. § 103(a). Specifically, to reject a claim based on this rationale, Office personnel must resolve the Graham factual inquiries.

Thereafter, Office personnel must then articulate the following:

- (1) **a finding that the prior art included each element claimed**, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference;
- (2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely would have performed the same function as it did separately;
- (3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and
- (4) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

It is the position of Appellant that under M.P.E.P. 2141 and rationale (A) of the Examination Guidelines set forth therein, Examiner has not adequately articulated a finding that the prior art included each **properly construed** element claimed with

the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference.

Specifically, claim 1 (and similarly claims 5, 8, and 12) recites a workflow system (and also a workflow server, a workflow engine and a method) for consolidating a workflow. For the convenience of the Examiner, exemplary claim 1 is reproduced herein as follows:

1. A workflow system comprising:
operating computer terminals executing a workflow; and
a workflow server connected with said operating computer terminals in a network to manage the workflow, wherein said workflow server consolidates information necessary for processing in multiple consecutive nodes to be processed by at least one participant operating one of said operating computer terminals, wherein when a form to be circulated in the workflow reaches a first one of the multiple consecutive nodes to be processed by the at least one participant, said workflow server consolidates information necessary for the at least one participant's determination, and wherein **said workflow server generates a new form based on the consolidated information and sends the new form with the consolidated information to the operating computer terminal for use by the at least one participant in make the participant's determination.**

Integral to claim 1 (and claims 5, 8, and 12 by extension) is the generation of a new form based on consolidated information and the sending of the new form with the consolidated information to a terminal for use by the participant.

In the Amendment dated February 12, 2010, Appellant argued that this limitation cannot be found in the combination of Bandat, Deborin and Dewan. For

the convenience of the Honorable Board, Appellant's argument in the Amendment dated February 12, 2010 is reproduced below:

Notwithstanding, on page 8 of the New Non-Final Office Action, Examiner refers to page 19, 185 and 248 of Deborin for this teaching. Page 19 of Deborin provides an overview of application integration provided by message brokering software to implement workflows between applications. Page 185 pertains to the development of "To-Be" process documentation using a forms based user interface as more expressly set forth on page 182 of Deborin. Yet further, page 248 of Deborin discloses the conversion of the "To-Be" model into a workflow model useable by the message brokering system through the consolidation of tasks to be performed by the same role into a single activity. However, nowhere in Deborin can a teaching be found directed to the "generation" (e.g. creation) of a new form based upon the consolidated information. Rather, Examiner has only located piecemeal a teaching of a form used to define a model (and not a form generated from consolidated information) and a teaching of consolidating tasks into an activity (and not a form).

On page 6 of the Final Office Action, the Examiner responded and stated:

Regarding the claim that the new form with the consolidated information is sent to the participant, Deborin [p.136] states "This information is now put onto the same Sales Order form, so we indicate this new "state" of the form by adding another Phi called "Sales Order Form". We will learn how to change the state of the Phi in "Add the data to the As-Is models" on page 155, where we assign data to objects." (emphasis added) where the form is clearly updated and obviously used by an appropriate user.)

Appellant respectfully disagrees with Examiner's analysis.

In particular, Appellant's claim 1 (and also claims 5, 8 and 12) require that the workflow server generates a new form based on consolidated information and that the workflow server sends the new form with the consolidated information to the operating computer terminal for use by a participant. At page 136 of Deborin, however, the "same Sales Order" form is modified or placed in a "new state".

Specifically, page 134 of Deborin provides for a "task object window" in which a sales order is entered. As stated on page 135, "Once you enter the order information, what you have with you is the filled-in Sales Order form". At page 135 of Deborin, it is further taught that the filled-in Sales Order form is represented by placing a "Phi" object with a type "Paper Form" in an "Activity Decision Flow Diagram". Thus, changing the state of the "Phi" object of Deborin is nothing more than changing the state of an object in a flow diagram. In no way, is the "Phi" object a new form based on consolidated information as an "object in a flow diagram" is in no way equivalent to a "form".

To the extent the Examiner, having considered the foregoing arguments, persists and prepares an Examiner's Answer, Examiner is reminded of Examiner's responsibility under M.P.E.P. 1207.02(A)(1)(9)(e) to map every claim term in claim 1 to the Bandat, Deborin and Dewan references. In this regard, for the convenience of the Examiner the entirety of is provided herein:

For each rejection under 35 U.S.C. 102 or 103 where there are questions as to how limitations in the claims correspond to features in the prior art even after the examiner complies with the requirements of paragraphs (c) and (d) of this section, the examiner must compare at least one of the rejected claims **feature by feature** with the prior art relied on in the rejection. **The comparison must align the language of the claim side-by-side with a reference to the specific page, line number, drawing reference number, and quotation from the prior art, as appropriate.**

Specifically, Examiner must point out with particularity the precise teaching in Bandat, Deborin and Dewan that maps to the claimed elements (1) generates a new form; (2) based on consolidated information, while applying the ordinary meaning of "new" and "consolidated" as a proper claim construction under M.P.E.P.

2111.01(I).¹

In view of the foregoing, reversal of the rejections under 35 U.S.C. § 103 is respectfully requested.

Date: December 9, 2010

Respectfully submitted,

/Steven M. Greenberg/
Steven M. Greenberg
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Customer Number 46320

¹ Although claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allow. In re American Academy of Science Tech Center, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004)

VIII. CLAIMS APPENDIX

1. (Previously Amended) A workflow system comprising:

operating computer terminals executing a workflow; and

a workflow server connected with said operating computer terminals in a network to manage the workflow, wherein said workflow server consolidates information necessary for processing in multiple consecutive nodes to be processed by at least one participant operating one of said operating computer terminals, wherein when a form to be circulated in the workflow reaches a first one of the multiple consecutive nodes to be processed by the at least one participant, said workflow server consolidates information necessary for the at least one participant's determination, and wherein said workflow server generates a new form based on the consolidated information and sends the new form with the consolidated information to the operating computer terminal for use by the at least one participant in make the participant's determination.

3. (Previously Amended) The workflow system of claim 1, wherein the operating computer terminal replies with said workflow server results of work performed by the at least one participant based on the consolidated information in the new form sent from said workflow server.

4. (Original) A workflow system according to claim 3, wherein said workflow server performs individual processing on each of the multiple nodes based on the results of work performed by the participant and sent from the operating computer terminal to advance the workflow.

5. (Previously Amended) A workflow server connected with multiple computer terminals to manage a workflow comprising:

means for storing a definition of nodes assigned to respective participants performing a workflow;

means for determining a range of consolidating multiple consecutive nodes to be processed by at least one participant in the workflow;

means for acquiring from said means for storing, a plurality of work items, wherein each of the plurality of work items is selectable for each node within the consolidation range determined by said means for determining a range of consolidation; and

means for consolidating the work items acquired by said means for acquiring to provide the at least one participant with consolidated information,

wherein when a form to be circulated in the workflow reaches a first one of the multiple consecutive nodes to be processed by the at least one participant, said

workflow server consolidates information necessary for the at least one participant's determination, and

wherein said workflow server generates a new form based on the consolidated information.

6. (Original) A workflow server according to claim 5, wherein:

the definition of nodes includes information relating to access permission to each field at each of the nodes; and

said workflow server further comprises highest-level access permission acquiring means for acquiring from said storage means the highest level of access permission to each field within the consolidation range determined by said consolidation range determining means.

7. (Previously Amended) A workflow server according to claim 6, wherein:

said means for storing stores a layout definition of a form used for time of one participant's continuous activities; and

providing means provides at least one participant with a form formatted based on the form layout definition acquired from said means for storing and a field access permission acquired from said highest-level access permission acquiring means.

8. (Previously Amended) A workflow engine connected with multiple computer terminals to manage a workflow comprising:

consolidation range determining means for determining a range of consolidating multiple consecutive nodes to be processed by at least one participant in the workflow;

access permission setting means for setting access permission to each field at each node within the consolidation range determined by said consolidation range determining means;

selectable work acquiring means for acquiring a plurality of work items, wherein each of the plurality of work items is selectable for each node within the consolidation range determined by said consolidation range determining means;

consolidating means for consolidating the work items acquired by said means for acquiring to provide the at least one participant with consolidated information, wherein the form to be circulated in the workflow reaches a first one of the multiple consecutive nodes to be processed by the at least one participant, said workflow server consolidates information necessary for the at least one participant's determination;

form generating means for generating a new form based on the access permission set by said access permission setting means and consolidating means; and

form sending means for sending the at least one participant the form generated by said form generating means.

10. (Previously Amended) A workflow engine according to claim 8, wherein when there are multiple work items that are selectable for a certain node, if routes determined for respective work items have no inclusion relationship with one another, said consolidation range determining means determines common part of the routes as the consolidation range.

11. (Original) A workflow engine according to claim 8, wherein said access permission setting means sets the highest level of access permission of the participant to each field defined on the form for each node as the access permission upon consolidation.

12. (Previously Amended) A workflow process consolidation method for consolidating a plurality of work items for each of multiple nodes assigned in a

workflow to at least one participant operating a computer terminal connected to a network, said method comprising the steps of:

determining the range of consolidating multiple consecutive nodes to be processed by the participant based on a workflow definition stored in a storage device;

acquiring work items selectable for each node within the determined consolidation range from the workflow definition stored in the storage device; and

consolidating the acquired selectable work items, wherein when a form to be circulated in the workflow reaches a first one of the multiple consecutive nodes to be provides by the at least one participant, said workflow server consolidates information necessary for the at least one participant's determination, generating a new form based on the consolidated information, and providing the participant with the new form with the consolidated information through the network.

13. (Previously Amended) A workflow process consolidation method according to claim 12, wherein when there are multiple work items that are selectable for a certain node, some routes in all the routes determined for respective work items, which are contained in one route, or common part of all the routes is determined in said consolidation range determining step as the consolidation range.

14. (Previously Amended) A workflow process consolidation method according to claim 12 further comprising the steps of:

determining the highest level of access permission to each field within the consolidation range from the workflow definition stored in the storage device; and

acquiring the layout definition of a form to be provided to the at least one participant from the workflow definition, wherein a form as consolidation information is generated in said consolidation information providing step based on the access permission and the layout definition.

15. (Previously Amended) A workflow process consolidation method according to claim 12 further comprising the steps of:

receiving results of work performed by the at least one participant on the consolidated information; and

storing in the storage device the at least one participant's inputted field values and the participant's selected work from the received results of work.

IX. EVIDENCE APPENDIX

No evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the Examiner has been relied upon by Appellants in this Appeal, and thus no evidence is attached hereto.

X. RELATED PROCEEDINGS APPENDIX

Since Appellants are unaware of any related appeals and interferences, no decision rendered by a court or the Board is attached hereto.